

ESTTA Tracking number: **ESTTA546227**

Filing date: **07/01/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201703
Party	Defendant Istituto Italiano Sicurezza dei Giocattoli S.r.l.
Correspondence Address	JEFFREY M GOEHRING YOUNG & THOMPSON 209 MADISON ST , STE 500 ALEXANDRIA, VA 22314-1764 UNITED STATES jgoehring@young-thompson.com, trademarks@young-thompson.com
Submission	Answer and Counterclaim
Filer's Name	Jeffrey Goehring
Filer's e-mail	jgoehring@young-thompson.com
Signature	/s/ Jeffrey Goehring
Date	07/01/2013
Attachments	2013-07-01 Answer and Counterclaim.pdf(22669 bytes)

Registration Subject to the filing

Registration No	1749733	Registration date	02/02/1993
Registrant	MICHAEL BRANDT FAMILY TRUST 3001 WHEELLOCK STREET SUITE A DALLAS, TX 75220 UNITED STATES		
Grounds for filing	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 025. First Use: 1972/00/00 First Use In Commerce: 1972/00/00 All goods and services in the class are requested, namely: apparel; namely, tee shirts and hats
Class 026. First Use: 1972/00/00 First Use In Commerce: 1972/00/00 All goods and services in the class are requested, namely: cloth patches for shirts

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MICHAEL BRANDT FAMILY TRUST
d/b/a ECO-SAFE OF DALLAS,

Opposer,

v.

ISTITUTO ITALIANO SICUREZZA
DEI GIOCATTOLI S.R.L.

Opposition No. 91201703

Application No. 77960950

Mark: ECO-SAFE

**ANSWER TO SECOND AMENDED NOTICE OF OPPOSITION
AND COUNTERCLAIM TO CANCEL OPPOSER'S REGISTRATION NO. 1,749,733**

\

For its Answer to the Second Amended Notice of Opposition filed by Michael Brandt Family Trust ("MBFT"), Istituto Italiano Sicurezza Dei Giocattoli S.R.L. ("Sicurezza") states as follows:

Likelihood of Confusion Under Section 2(d)

- 1) Applicant has insufficient knowledge to form a belief as to the truth of Opposer's allegations in numbered paragraph 1 of the Second Amended Notice of Opposition and denies the same for that reason.
- 2) Applicant has insufficient knowledge to form a belief as to the truth of Opposer's allegations in numbered paragraph 2 of the Second Amended Notice of Opposition and denies the same for that reason.
- 3) Applicant has insufficient knowledge to form a belief as to the truth of Opposer's allegations in numbered paragraph 3 of the Second Amended Notice of Opposition and denies the same for that reason.

4) Applicant admits that Opposer relies on Registration Nos. 1,749,733; 1,631,876; and 1,303,116. Applicant has insufficient knowledge to form a belief as to the truth of Opposer's remaining allegations in numbered paragraph 4 of the Second Amended Notice of Opposition and denies the same for that reason; except as to the validity of Reg. 1,749,733, which is denied upon information and belief.

5) Denied.

6) Denied.

7) Admit.

8) Denied.

Violation of the Anti-Use by Owner Rule for Certification Marks

9) This paragraph requires no response.

10) Admit; however, to the extent that this allegation alleges that certain content appears on Applicant's website; Applicant notes that its website speaks for itself and denies such portions on this basis.

11) This allegation alleges that certain content appears on Applicant's website. Applicant's website speaks for itself and Applicant denies this paragraph on this basis.

12) This allegation alleges that certain content appears on Applicant's website. Applicant's website speaks for itself and Applicant denies this paragraph on this basis.

13) This allegation alleges that certain content appears on Applicant's website. Applicant's website speaks for itself and Applicant denies this paragraph on this basis.

14) This allegation alleges that certain content appears on Applicant's website. Applicant's website speaks for itself and Applicant denies this paragraph on this basis.

15) This allegation alleges that certain content appears on Applicant's website. Applicant's website speaks for itself and Applicant denies this paragraph on this basis.

16) Admit; however, to the extent that this allegation alleges that certain content appears on Applicant's website; Applicant notes that its website speaks for itself and denies such portions on this basis.

17) Admit.

18) Admit.

Application is void for a lack of bona fide intent to use the mark for the stated goods and services

19) This paragraph requires no response.

20) Applicant admits that it is in part a certifying entity. This allegation is not limited to the mark that appears in Applicant's application at issue and appears to cover *all* of Applicant's marks and activities. However, it is unclear how broad this allegation is meant to be. Based on this ambiguity, Applicant denies the remainder of this allegation. Also, to the extent that this allegation alleges that certain content appears on Applicant's website; Applicant notes that its website speaks for itself and denies such portions on this basis.

21) Applicant admits that its application should be declared void because it was erroneously not characterized as a certification mark in its application, and denies the remainder of this paragraph.

22) Applicant admits that its application should be declared void because it was erroneously not characterized as a certification mark in its application, and denies the remainder of this paragraph.

Fraud

- 23) This paragraph requires no response.
- 24) Denied.
- 25) Denied.
- 26) Denied.
- 27) Denied.
- 28) Denied.
- 29) Denied.
- 30) Denied.

AFFIRMATIVE DEFENSES

- a) There is no likelihood of confusion.
- b) Applicant's statements of use were not fraudulent.
- c) Opposer's Reg. No. 1,749,733 should be cancelled on the basis of fraud or abandonment, and/or should be modified to eliminate Classes 25 and 26 on the basis of nonuse.

COUNTERCLAIM FOR CANCELLATION OF REG. NO. 1,749,733

For its counterclaim against Opposer Michael Brandt Family Trust ("MBFT"), Applicant Istituto Italiano Sicurezza Dei Giocattoli S.R.L. ("Sicurezza") states as follows:

- 1. Applicant believes that it is and will continue to be damaged by Opposer's Registration No. 1,749,733 cited in Opposer's Second Amended Notice Of Opposition and, pursuant to 15 U.S.C. §§ 1064 *et seq.* and 37 C.F.R. §§ 2.11 *et seq.*, hereby petitions to cancel the same.

Fraud

2. On September 25, 1991 Opposer filed a Section 1(a) use-based Application, Serial No 74/206842, for registration on the Principal Register the mark ECO-SAFE in Class 25 for “tee shirts and hats” and in Class 26 for “cloth patches for shirts”, among other goods and services in other classes, for all of which Opposer swore to a date of first use in interstate commerce in 1972.
3. Said application matured into Registration No. 1,749,733 on February 2, 1993.
4. On February 7, 1999, Opposer submitted a Combined Declaration Under Sections 8 and 15 wherein it swore to the continued use of “tee shirts and hats” in Class 25 and “cloth patches for shirts” in Class 26 in interstate commerce, as well as to continuous use in interstate commerce of the mark for these goods for the previous five years and from the date of registration.
5. On September 23, 2002, Opposer submitted a Combined Application for Renewal Under Section 9 and Declaration of Continued Use Under Section 8 of Trademark Registration wherein it swore to the continued use of “tee shirts and hats” in Class 25 and “cloth patches for shirts” in Class 26 in interstate commerce.
6. On February 5, 2013, Opposer submitted a sworn COMBINED APPLICATION FOR RENEWAL UNDER SECTION 9 AND DECLARATION OF CONTINUED USE UNDER SECTION 8 OF TRADEMARK REGISTRATION, wherein it swore to the continued use of “tee shirts and hats” in Class 25 and “cloth patches for shirts” in Class 26 in interstate commerce.
7. In paragraph 1 of its Second Amended Notice of Opposition, Opposer does not allege any use in connection with tee shirts, hats, or cloth patches of the marks upon which it relies

for its Opposition, though it does allege continuous and interstate commerce use of all of the other goods and services listed in the registrations upon which it relies.

8. Opposer's website, ecosafepest.com, does not sell, offer for sale, give away, distribute, or otherwise display, or mention in any way tee shirts, hats, or cloth patches.
9. Opposer operates out of no more than two locations, both located in the Dallas-Fort Worth area of Texas.
10. Opposer is not in the business of selling tee shirts, hats, or cloth patches and does not sell tee shirts, hats, or cloth patches.
11. Upon information and belief, Opposer does not give away or otherwise distribute tee shirts, hats, or cloth patches.
12. Upon information and belief, Opposer has not given away or otherwise distributed tee shirts, hats, or cloth patches continuously in interstate commerce since 1972.
13. Upon information and belief, Opposer's sales, gifting, distributions, or promotional transfers of tee shirts, hats, or cloth patches bearing the ECO-SAFE mark, if any, have not constituted interstate commerce.
14. One or more of Opposers's sworn statements to the Patent and Trademark Office identified in paragraphs 4-6 above was false in that, with respect to the timeframe relevant to each statement, Opposer did not use the mark in connection with tee shirts, hats, or cloth patches as it stated, and/or such use, if any, did not constitute interstate commerce as it stated.
15. Each of Opposer's sworn statements to the Patent and Trademark identified in paragraphs 4-6 above was material to Opposer's application for registration.

16. Upon information and belief, Opposer made the false, material statements identified in paragraphs 4-6 above with knowledge that they were false and material and with intent to deceive the Patent and Trademark Office and to induce the Patent and Trademark Office to register the mark.
17. One or more of Opposer's statements identified in paragraphs 4-6 above constitute fraud, for which Registration No. 1,749,733 should be canceled.

WHEREFORE, Applicant requests that Registration No. 1,749,733 is canceled.

Dated: July 1, 2013

Respectfully submitted,

/Jeffrey Goehring/
Jeffrey Goehring
jgoehring@young-thompson.com
Young & Thompson
209 Madison Street, Suite 500
Alexandria, VA 22314
703-521-2297

attorney for Applicant

Certificate of Service

I herby certify that the within ANSWER AND COUNTERCLAIM was served on this 1st day of July 2013 via U.S. mail, postage prepaid, to the below listed counsel of record for

Applicant:

Barth X. deRosa
Dickinson Wright PLLC
1875 Eye Street NW, Suite 1200
Washington, DC 20006

/Jeffrey Goehring/
Jeffrey Goehring